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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,273	12/14/2001	Lirio Quintero	154-26969-US	3997
23770	7590	08/26/2004		
PAULA D. MORRIS & ASSOCIATES, P.C. d/b/a THE MORRIS LAW FIRM, P.C. 10260 WESTHEIMER, SUITE 360 HOUSTON, TX 77042-3110			EXAMINER TUCKER, PHILIP C	
			ART UNIT 1712	PAPER NUMBER
DATE MAILED: 08/26/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

SC

Office Action Summary

Application No.

10/023,273

Applicant(s)

QUINTERO, LIRIO

Examiner

Philip C Tucker

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 329-391, 413 and 415-602 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 329-391 and 576-602 is/are allowed.
- 6) ☒ Claim(s) 413, 415-435, 440-444, 446-471, 474, 476-501, 508-544 and 549-575 is/are rejected.
- 7) ☒ Claim(s) 436-439, 445, 472, 473, 475, 502-507 and 545-548 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 510 and 511 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 510 and 511 fail to further limit the concentration of emulsifiable material of parent claims 508 and 509. Since the same quantities are being claimed, it would inherently provide the lubricating properties. The term "further comprising" is also used, whereas the parent claims already comprise the same emulsifiable material.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 425, 429 and 432-440 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims all depend from cancelled claim 414, thus the scope of the claims is not definite.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 413-415, 422, 425, 429, 430, 432-435, 440, 441, 446-471, 474, 476, 481, 482, 484, 487-500, 508-524, 531, 534, 540-544, 549-551, 555, 556, 560-562, 566-575 are rejected under 35 U.S.C. 102(b) as being anticipated by House (5977030).

House teaches a water in oil fluid which is used as a drilling fluid which comprises an oligosaccharide surfactant and a xanthan polymer (see the examples). The xanthan used would have molecular weights within the scope of the present invention (see column 4, lines 24-34). Other polymers, such as starch derivatives may be used in the drilling fluid (see column 4, lines 56-65). Fluids such as olefins and polyalphaolefins may be used as the internal phase, up to a level of about 30% (see column 3, lines 20-26 and example 1). Such would inherently possess fluid loss, rheology and surface tension properties within the scope of the present invention.

3. Claims 413-435, 440-444, 446-471, 476-501, 508-544 and 549-575 are rejected under 35 U.S.C. 102(b) as being anticipated by Peignier (4894335).

Peignier teaches an oil in water emulsion (see abstract and claims) which comprises a biopolymer such as xanthan having a weight within the scope of the present invention (column 2, lines 34-40), surfactants, such as sulfates, within the scope of the present invention (column 3, lines 22-30), and an oil phase within the scope of the

invention (column 2, line 62 – column 3, line 5). Such would inherently have fluid loss and reduced surface tension properties within the scope of the present invention.

4. Claims 436-439, 445, 472, 473, 475, 502-507, 545-548 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claims 329-391 and 576-602 are allowable over the art of record.
6. Applicants amendment to claim 508, such that the concentration of emulsifiable material is 20% or less distinguishes over Blanco. Applicants other arguments have been considered but are not deemed persuasive. Applicants initially argue that the polymer and surfactant of House are the same. It is clear that the OSM mixture is a surfactant mixture, and the polysaccharide, such as Xanthan is a different entity than the OSM. Such are associated in the aqueous phase of the mixture. House has clearly stated that effective low shear rate (rheology measurement) is one of the features of the fluid (column 1, lines 61-65). Applicant has not given any specific fluid loss values that are superior and unexpected for the present invention. House even teaches that the fluid may be provided with effective fluid loss, by using additives (column 5, lines 19-25). Such properties are thus not seen as distinguishing. The fluid taken as a whole including the polymer and surfactant would clearly provide effective fluid loss control.

With respect to Peignier, applicant has argued that the LSRV of 70,000 cP at 0.3 rpm distinguishes over the reference. The low 0.3 rpm used by applicant would clearly give much higher viscosity measurements than the much higher rate given by Peignier. Since the compositions of Peignier and the present invention are the same, the burden of proof shifts to the applicant to prove that the reference does not possess that characteristics recited in the claims (In re Fitzgerald 205 USPQ 597). Applicant has not provided any evidence that the compositions of Peignier would not possess the claimed characteristics, and has thus not met the responsibility. These rejections are thus maintained.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-3097